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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,702	11/21/2001	Hayato Kikuchi	108426-00010	9591

4372 7590 07/30/2004

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[REDACTED] EXAMINER

BOTTORFF, CHRISTOPHER

ART UNIT	PAPER NUMBER
	3618

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/989,702	KIKUCHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Christopher Bottorff	3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 June 2004.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 7-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 7-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

The amendment filed April 29, 2004 has been entered. Claims 7-10 are pending.

### ***Claim Objections***

Claim 7 is objected to because of the following informalities: Lines 21 and 22 recite the limitation "means for capable of". The limitation would be more clear if the term "for" or the expression "capable of" were deleted. Appropriate correction is required. For the purposes of examination, this limitation is interpreted as reciting "means capable of" with the term "for" deleted by amendment, which is consistent with a similar amendment to claim 8.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Kakinami et al. US 5,230,400.

Kakinami et al. discloses an auto-cruise apparatus having a vehicle to vehicle distance controller within CPU 3, input means SW4-SW7 that enable a driver to set a vehicle to vehicle distance and a vehicle speed, a constant vehicle speed controller

within CPU 3, and a mode selector within CPU 3. The input means includes a cruise switch SW 6 and a vehicle-to-vehicle distance setting means SW 7 for setting the set vehicle to vehicle distance. Furthermore, this apparatus functions as claimed. See column 5, lines 3-5 and 65-68, column 6, lines 1-68, column 7, lines 1-8 and 55-68, and column 8, lines 1-64.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kakinami et al. US 5,230,400 in view of Nishimura US 5,695,020.

Kakinami et al. discloses the apparatus as described above, but does not disclose that the apparatus operates as a function of the operating time of the input means as defined in claims 8 and 9. However, Nishimura teaches that the practice of controlling the operation of an auto-cruise apparatus as a function of the operating time of the input means was old and well known in the art at the time the invention was made. See column 7, lines 38-62, and column 8, lines 39-46. From the teachings of Nishimura, operating the system of Kakinami et al. as a function of the operating time of the input means would have been obvious to one of ordinary skill in the art at the time

the invention was made. This would allow a switch input means to perform multiple functions without the need for additional switches.

### ***Response to Arguments***

Applicant's arguments filed April 29, 2004 have been fully considered but they are not persuasive.

After careful reconsideration, the indication of allowability of claims 9 and 10 is withdrawn. Kakinami et al. disclose a vehicle-to-vehicle distance setting means SW 7 that is capable of establishing a long, middle, or short distance. SW 7 can be pressed by an operator at an appropriate moment to selectively choose either a long, middle, or short distance. Moreover, this feature of the distance setting means is defined in the claims in terms of function, rather than structure, without invoking 35 USC 112, sixth paragraph.

Applicant alleges that the vehicle-to-vehicle distance setting means of the claimed apparatus is distinguished from the structures of the prior art due to the manner in which it is capable of functioning. However, this alleged distinction is irrelevant to the patentability of the claimed apparatus.

It is well settled that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). “[A]pparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). Thus,

the functional limitations cited in the remarks do not distinguish the claimed apparatus from the structures of the prior art. Also, the functional limitations at issue do not fall within the purview of 35 USC 112, sixth paragraph, since Applicants have not invoked 35 USC 112, sixth paragraph. (Guidance on how to properly invoke 35 USC 112, sixth paragraph, is provided in section 2181 of the MPEP.)

In addition, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all of the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Here, Kakinami et al. teach all of the structural limitations of the claims. Thus, Applicant's claims fail to distinguish the present invention over the prior art.

Furthermore, the vehicle-to-vehicle distance setting means of Kakinami et al. is capable of functioning as claimed by Applicant. SW 7 can be pressed by an operator at an appropriate moment to selectively change the vehicle-to-vehicle distance from a long distance to a short distance or from a short distance to a long distance, as defined in claims 7 and 8. That is, Ls, Lu, and Ld can be changed (i.e. reset) from a long distance to a shorter distance, and vice versa, upon SW 7 being pressed by an operator.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (703) 308-2183. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Christopher P. Ellis

  
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